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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,592	08/13/2001	Jess Paul Fuller	V0005/7097	9457

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EXAMINER

NAFF, DAVID M

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 04/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830592

Applicant(s)

Fallor et al

Examiner

K/rtt

Group Art Unit

1/651

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/30/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-39, 41 + 43-161 is/are pending in the application.
- ☐ Of the above claim(s) 44-161 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-39, 41 + 43 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

In a response of 1/30/03 to a restriction requirement of 11/25/02, applicants amended claims 44, 70, 78, 90, 100, 116, 123, 128, 138, 143, 150 and 157, and elected Group I claims 1-39, 41 and 43 with traverse.

In the traverse, applicants urge that the inventions of the
5 different groups are not restrictable since claims 44, 70, 78, 90, 100, 116, 123, 128, 138, 143, 150 and 157 have been amended to depend on claim 41. However, this fails to obviate the restriction since in claim 41, the silicone rubber is "obtained or obtainable" by the method of claim 1. Therefore, the silicone rubber of Groups II-XIV can be obtainable rather
10 than obtained by the method of claim 1, and the silicone rubber in Group I can be different than in Groups II-XIV. A silicone rubber "obtained" by the method of Group I can be different from that "obtainable" by the method, and can have uses other than in the devices of Groups II-XIV. The apparatus in Group I can be different than required in Groups II-XIV.
15 Groups II-XIV require apparatus that are distinct from each other since each group requires different apparatus structure such that each apparatus can be produced and used without producing and using the other. Accordingly, the restriction requirement is adhered to and made final.

Claims 44-161 are withdrawn from further consideration pursuant to
20 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8 of 1/30/03.

Claims examined on the merits are 1-39, 41 and 43.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

5 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

 Claims 1-39, 41 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the
10 invention.

 The claims are confusing and unclear by reciting "sacrificial filler" in claim 1, and where recited in other claims, since being "sacrificial" is relative and subjective, and it would be uncertain as to when a filler is sacrificial and not sacrificial. It is suggested the
15 term be deleted from the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

20 A person shall be entitled to a patent unless -

 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

25 Claims 1-7, 11, 15, 16, 25-36, 41 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuller (WO 97/08291), (6,444,459 B1) or (6,130,080).

 The claims are drawn to a method making a silicone rubber having a structure adapted for growth of cells or tissue by contacting a silicone

rubber precursor with a filler, curing the resulting mixture and removing the filler.

Fuller discloses (for example, see page 4, lines 1-20, of Fuller WO) providing a growth surface for cells by coating the inside surface of a growth bottle with a silicone paint, adding salt particles to the
5 silicone paint coating while still liquid, polymerizing the coating to form a solid layer, and removing the salt particles by dissolution in water to leave a porous layer.

The method disclosed by Fuller for producing silicone rubber, and
10 resultant silicone rubber and apparatus are the same as presently claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time
20 the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes
25 that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8-10, 12-14, 17-24 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller (WO 97/08291), (6,444,459 B1) or
5 (6,130,080), and if needed in view of Fuller et al (5,998,185).

The claims are drawn to specific forms of filler or silicone rubber structure.

Fuller is described above.

Fuller et al disclose immobilizing cells with a silicone rubber foam
10 support.

The conditions of the present claims would have been matters of obvious choice in view of the disclosure of Fuller, and if needed Fuller et al.

Double Patenting

15 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29
20 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

25 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

30 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39, 41 and 43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1-20 of U.S. Patent No. 6,444,459 B1 or 6,130,080. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed method making a silicone rubber, resultant silicone rubber and apparatus containing the silicone rubber would have been obvious from the method of producing a porous silicone rubber and apparatus claimed by the patents.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is (703) 308-0520. The examiner can normally be reached on Monday-Thursday and every other Friday from about 8:30 AM to about 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, a message can be left on voice mail.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached at telephone number (703) 308-4743.

The fax phone number is (703) 872-9306 before final rejection or (703) 872-9307 after final rejection.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


DAVID M. NAFF
PRIMARY EXAMINER
ART UNIT 12651